

REMARKS/ARGUMENTS

Claims 20-29 and 32-68 are pending. Claims 1-19 and 30-31 are canceled. Claims 24-29, 35, 36, 46-52, and 57-61 are withdrawn pursuant to a Restriction Requirement. Claims 20-23, 32-34, 37-45, 53-56, and 62-68 are currently under examination and stand substantively rejected. In this Amendment, claims 20, 41, and 67 are amended, and claim 65 is canceled. Reconsideration of the claims is respectfully requested.

Claim Amendments

The claim amendments conform with the Group and Species (i.e. Group II and Species I/Fig. 2) which were elected in response to the Restriction Requirement dated January 9, 2007. Support for amended claims 20, 41, and 67 can be found in the originally filed disclosure at, for example, paragraphs [0030] and [0034]. No new matter is introduced.

Rejection Under 35 U.S.C. §102

Claims 20-23, 32-34, 37, 39, 40, and 63 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent Publication No. 2003/0010346 to Paolitto et al. ["Paolitto"]. This rejection is traversed.

According to MPEP 2131, in order to anticipate a claim, a reference must teach each and every element of the claim. Paolitto does not meet this test.

Independent Claim 20

Amended claim 20 is directed to a system for enhancing minimally invasive heart surgery. The system includes, among other things, a heart stabilizing device, a source of suction, and a first coupling device. The source of suction is attached with the coupling device and applies a vacuum to the flexible, rigidifying portion of the elongate shaft of the coupling device.

Paolitto describes a surgical apparatus for transabdominal cardiac surgery. The Office Action alleges that the presently claimed rigidifying portion of the first coupling device is read on by the permanent weir (30) of Paolitto. However, Paolitto does not teach or suggest a source of suction that applies a vacuum to a rigidifying portion as presently claimed. Instead, Paolitto describes introducing pressurized CO₂ into the pleural space and thoracic cavity. The

permanent weir operates as buttress, and pressure loads on the cannula maintain engagement with the diaphragm through the permanent weir. See Paolitto at paragraph [0056].

Because Paolitto does not disclose a source of suction that applies a vacuum to a rigidifying portion as presently claimed, Paolitto does not anticipate amended claim 20.

Presently pending claims 21, 22, 23, 32-34, 37, 39, 40, and 63 depend directly or indirectly from amended claim 20, and are therefore allowable for depending from an allowable base claim, as well as for the novel combination of elements they recite. Withdrawal of this rejection is respectfully requested.

Dependent Claim 32

Presently pending claim 32 is drawn to a system for enhancing minimally invasive heart surgery. The system includes, among other things, a first flexible arm for coupling a first coupling device with at least one stable object, and a second flexible arm for coupling a second coupling device with the at least one stable object.

The Office Action alleges that Paolitto's mechanical arm (50) reads on the presently claimed flexible arms. Applicants disagree. As described in Paolitto at paragraphs [0058] and [0061], Paolitto's mechanical arm (50) includes an articulation rod assembly (540) having certain pivoting capabilities. See Paolitto at paragraph [0061]. However, Paolitto does not indicate that mechanical arm (50) is flexible as presently claimed. Hence, Paolitto does not anticipate presently pending claim 32, or claims 33 and 34 which depend therefrom.

First Rejection Under 35 U.S.C. §103

Claims 41-43, 45, 53-54, 56, and 65 were rejected under 35 U.S.C. §103(a) as allegedly obvious over Paolitto. This rejection is traversed.

According to MPEP 2143(A), a *prima facie* case of obviousness requires, among other things, that when a single reference is cited in a §103 rejection, the cited reference, or any obvious modification thereof, must teach or suggest all the claim elements. Paolitto does not meet this test.

Independent Claim 41

Amended claim 41 is directed to a device for enhancing minimally invasive heart surgery. The device includes a surgical tool having a ball, a source of suction, and an elongate

coupling member with a flexible rigidifying portion. The source of suction is attached with the elongate coupling member and applies a vacuum to the flexible rigidifying portion.

As noted above, Paolitto does not teach or suggest a source of suction that applies a vacuum to a rigidifying portion. Instead, Paolitto describes introducing pressurized CO₂ into the pleural space and thoracic cavity. Because Paolitto does not disclose a source of suction that applies a vacuum to a rigidifying portion as presently claimed, Paolitto does not anticipate amended claim 41.

Presently pending claims 42, 43, 45, 53, 54, and 56, depend directly or indirectly from amended claim 41, and are therefore allowable for depending from an allowable base claim, as well as for the nonobvious combination of elements they recite. Claim 65 is canceled. Withdrawal of this rejection is respectfully requested.

Second Rejection Under 35 U.S.C. §103

Claim 38 was rejected under 35 U.S.C. §103(a) as allegedly obvious over Paolitto in view of U.S. Patent Publication No. 2002/0068855 to Daniel et al. ["Daniel"]. This rejection is traversed.

According to MPEP 2143, a *prima facie* case of obviousness requires, among other things, that the cited references when combined must teach or suggest all of the claim elements. The combination of Paolitto and Daniel does not meet this test.

Presently pending claim 38 depends indirectly from amended claim 20. As noted above, Paolitto does not teach or suggest a source of suction that applies a vacuum to a rigidifying portion of coupling device. Daniel discusses an endoscopic retraction system, but does not remedy this deficiency of Paolitto. Thus, the combination of Paolitto and Daniel does not show all elements of amended base claim 20, or claim 38 which depends therefrom. Withdrawal of this rejection is respectfully requested.

Third Rejection Under 35 U.S.C. §103

Claims 44 and 55 were rejected under 35 U.S.C. §103(a) as allegedly obvious over Paolitto in view of U.S. Patent Publication No. 2003/0060685 to Houser et al. ["Houser"]. This rejection is traversed.

According to MPEP 2143, a *prima facie* case of obviousness requires, among other things, that the cited references when combined must teach or suggest all of the claim elements. The combination of Paolitto and Houser does not meet this test.

Presently pending claims 44 and 55 depend directly or indirectly from amended claim 41. As noted above, Paolitto does not teach or suggest a source of suction that applies a vacuum to a rigidifying portion of an elongate coupling member. Houser discusses a shape memory tissue stabilizer, but does not remedy this deficiency of Paolitto. Thus, the combination of Paolitto and Houser does not show all elements of amended base claim 41, or claims 44 and 55 which depends therefrom. Withdrawal of this rejection is respectfully requested.

Fourth Rejection Under 35 U.S.C. §103

Claims 62, 64, and 66-68 were rejected under 35 U.S.C. §103(a) as allegedly obvious over Paolitto in view of U.S. Patent Publication No. 2003/0010346 to Peng et al. ["Peng"]. This rejection is traversed.

According to MPEP 2143, a *prima facie* case of obviousness requires, among other things, that the cited references when combined must teach or suggest all of the claim elements. The combination of Paolitto and Peng does not meet this test.

Claims 62 and 64

Presently pending claims 62 and 64 depend from amended claim 20. As noted above, Paolitto does not teach or suggest a source of suction that applies a vacuum to a rigidifying portion. Peng is cited for allegedly describing a rigidifiable arm coupled with a coupling device. However, Peng does remedy the deficiency of Paolitto's coupling device. Thus, the combination of Paolitto and Peng does not show all elements of amended base claim 20, or claims 62 and 64 which depend therefrom.

Claim 66

Presently pending claim 66 depend from amended claim 41. As noted above, Paolitto does not teach or suggest a source of suction that applies a vacuum to a rigidifying portion. Peng is cited for allegedly describing a rigidifiable arm coupled with a coupling device. However, Peng does remedy the deficiency of Paolitto. Thus, the combination of Paolitto and

Peng does not show all elements of amended base claim 41, or claim 66 which depends therefrom.

Claims 67 and 68

Amended independent claim 67 is drawn to a system for enhancing minimally invasive heart surgery. The system includes, among other things, a source of suction attached with a coupling device that applies a vacuum to a flexible rigidifying portion of the coupling device.

As noted above, Paolitto does not teach or suggest a source of suction that applies a vacuum to a rigidifying portion. Peng is cited for allegedly describing a rigidifiable arm coupled with a coupling device. However, Peng does remedy the deficiency of Paolitto's coupling device. Thus, the combination of Paolitto and Peng does not show all elements of amended base claim 67, or claim 68 which depends therefrom. Withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

/Nathan S. Cassell/

Nathan S. Cassell
Reg. No. 42,396

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
61268375 v1